

REMARKS

Upon receipt of this response, the Examiner is respectfully requested to contact the undersigned representative of the Applicant to arrange a telephone interview concerning the inventive merits of this application.

The drawings are objected to for the reasons noted in the official action, e.g., the failure to include any drawing showing the claimed features. The raised drawing objection is believed to be overcome by the accompanying new formal drawing. If any further drawing amendment is believed necessary, the Examiner is invited to contact the undersigned representative of the Applicant to discuss the same.

The specification is then objected to for the reasons noted in the official action, e.g., the failure to provide antecedent basis for a "coasting mode." The above requested specification amendments are believed to overcome the raised informalities concerning this specification. Upon reviewing this application, it was noted that there are a few inaccuracies between the original German application and the supplied English translation of the specification. Namely, the German terms "Schubbetrieb" and "Schubbetriebsphase," which translate as "coasting" and "coasting mode," were either mistranslated or such term was completely left out in the originally filed English translation of the specification. The above revised paragraphs of the specification correct the above noted inaccuracies contained in the original English translation of the specification. It is respectfully submitted that no new matter is entered by the same. However, if any further amendment to the specification is believed necessary, the Examiner is invited to contact the undersigned representative of the Applicant to discuss the same.

Next, claims 23-32 and 34-36 are rejected under 35 U.S.C. § 112, first and second paragraph, as failing to provide an inadequate written description and as being indefinite for the reasons noted in the official action. The rejected claims are accordingly amended, by the above claim amendments, and all of the presently pending claims are now believed to particularly point out and distinctly claim the subject matter regarded as the invention, thereby overcoming all of the raised § 112, second paragraph, rejections. The entered claim amendments are directed solely at overcoming the raised indefiniteness rejection(s) and are not directed at distinguishing the present invention from the art of record in this case. Please note that the objection relating to the requirement that the threshold speed be greater than zero will be discussed later below.

Claims 23-28, 30-31 and 34-36 are rejected, under 35 U.S.C. § 102, as being anticipated by Nitta '275. The Applicant acknowledges and respectfully traverses the raised anticipatory rejection in view of the following remarks.

Before discussing the applied prior art in detail, the Applicant would first like to summarize the inventive aspects of the presently claimed invention. As presently claimed, the present invention relates to and covers a method of operating an automatic transmission of a motor vehicle having a clutch located between a drive motor and the transmission. The method comprises the steps of disengaging a clutch, if engaged, and initiating a first downshift operation only when the vehicle is currently coasting. Shifting from a first, higher transmission gear ratio to a second, lower transmission gear ratio. Completing the first downshifting operation, if the speed of the vehicle is above a predetermined threshold speed greater than zero determined by the second transmission gear ratio, by engaging the clutch or alternatively, completing the first downshifting operation, if the speed of the vehicle is below the predetermined threshold speed, while maintaining the clutch in a disengaged state.

Turning now to the applied art, Nitta '275 relates to and concerns a shift control apparatus for an automatic vehicle transmission. More specifically, Nitta '275 discloses a means and a method for controlling the shifting of an automatic transmission *based on the steering angle of a wheel*. While Nitta '275 does disclose the nebulous step of querying whether the "shifting operation allowed in accordance with vehicle speed and throttle opening degree," it is respectfully submitted that Nitta '275 does not in any way teach, suggest, disclose or remotely hint at requiring that the vehicle to be currently coasting when shifting occurs.

It is to be appreciated that the term "coasting" is a more specific condition than "speed and throttle opening" referred to by Nitta '275. Coasting is a vehicle state in which the vehicle is in motion with zero thrust being applied by the engine. Merriam-Webster Dictionary defines coasting as "to move along without or as if without further application of propulsive power (e.g., as by momentum or gravity)." According to this conventional and well understood definition of the term "coasting," *in order for a vehicle to be coasting, the vehicle must be in motion and thus cannot have a speed of zero*.

In order to emphasize the above noted distinctions between the presently claimed invention and the applied art, independent claim 23 now recites the features of "disengaging the clutch, if engaged, and initiating a first downshift operation only when the vehicle is currently coasting; shifting from a first, higher transmission gear ratio to a second, lower transmission

gear ratio during coasting while the clutch is disengaged and without any engine braking of the vehicle". The remaining independent claims include similar limitations. Such features are believed to clearly and patentably distinguish the presently claimed invention from all of the art of record, including the applied art.

Further, with regard to the 35 U.S.C. § 112 rejection concerning the threshold speed being greater than zero, this requirement is clearly provided for in the specification when the definition of the term "coasting" is taken into consideration. The presently claimed inventive method concerns a situation when a vehicle is coasting. As stated above, by definition, coasting requires that a vehicle be in motion ("to move along without or as if without further application of propulsive power"), and the presently claimed invention requires that a vehicle be coasting. Therefore, the presently claimed invention requires that the vehicle be moving. If the vehicle reaches a speed of zero (i.e., the vehicle stops moving), then the vehicle, by definition, is no longer moving or coasting as required by the presently claimed invention. By definition, it is respectfully submitted that a vehicle may be coasting at all speeds at which the vehicle is moving, but specifically excludes a vehicle speed of zero, i.e., at a speed of zero - by definition - a vehicle is no longer moving and thus can no longer be coasting. Simply stated, the threshold speed must be greater than zero, because only such speeds allow the vehicle to be and remain coasting, as required by the presently claimed invention.

In view of the foregoing, the Applicant respectfully submits that all of the raised rejections should be withdrawn at this time. However, if any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that all of the raised rejection(s) should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejection(s) or applicability of the Nitta '275 reference, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying on his/her expertise in this field, the Applicant

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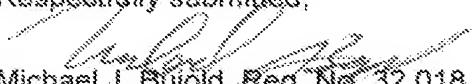
respectfully requests the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

In view of the foregoing, it is respectfully submitted that the raised rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

The Applicant respectfully requests that any outstanding objection(s) or requirement(s), as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,


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